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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,712	09/11/2000	Peter Heiler	A-2528	4157
24131	7590	12/18/2006	EXAMINER	
LERNER GREENBERG STEMER LLP			CRENSHAW, MARVIN P	
P O BOX 2480			ART UNIT	PAPER NUMBER
HOLLYWOOD, FL 33022-2480			2854	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/18/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/658,712	HEILER ET AL.
	<b>Examiner</b> Marvin P. Crenshaw	<b>Art Unit</b> 2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on the amendment filed on 10/14/2006.
- 2a) This action is FINAL.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 - 3, 5, 6, 9 - 14 and 17 - 22 is/are pending in the application.
- 4a) Of the above claim(s) 1 - 3, 5, 6 and 9 - 14 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 17 - 22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11 September 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>05/09/2001</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION*****Election/Restrictions***

This application contains claims directed to the following patentably distinct species: Species I - Figs 3 and 4; Species II - Figs 5 and 6; and Species III - Fig. 7. The species are independent or distinct because each species are mutually exclusive from each other.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

During a telephone conversation with Warner Stemer on December 6, 2006 a provisional election was made with traverse to prosecute the invention of Species II. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1 – 3, 5, 6 and 9 – 14 are withdrawn from further

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consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiba et al. (5,429,046) and in view of Koppelkamm et al. (5,848,570).

With respect to claims 17 and 20, Shiba et al. teaches a rotatable body (Fig. 1, 1) for printing machines having rollers comprising a circumferential surface provided with a surface structure (See col. 2, lines 6 - 10) and formed of a nonmetallic material (See col. 2, lines 6 - 10), said circumferential surface carrying a liquid (See col. 1, lines 30 – 38) and being a ductor roller for periodically contacting another roller of the rollers, said surface structure being irregularly structured (See col. 2, lines 6 - 10).

However, Shiba et al. does not teach a surface structure is made of dimples.

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Koppelkamm et al. teaches a surface structure that is made up of a multiplicity of dimples (depressions; See col. 4, lines 55 - 60) formed in the circumferential surface.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shiba et al. to have a surface structure made up of a multiplicity of dimples as taught by Koppelkamm et al. in order to hold ink for inking a transfer roller.

With respect to claims 18 and 21, Shiba et al. teaches a rotatable body (Fig. 1) wherein the nonmetallic material (See Col.2, lines 6 – 10) is a material selected from the group consisting of soft rubber, soft plastic material, hard rubber, and hard plastic material.

Claims 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiba et al. (5,429,046) in view of Koppelkamm et al. (5,848,570), as applied to claims 17, 18, 20 and 21 above, and further in view of Fischer (4,148,256).

With respect to claim 19 and 22, However, Shiba et al. as modified by Koppelkamm et al. does not teach a rotatable body wherein the circumferential surface carries a material selected from the group consisting of a viscid liquid, offset printing ink, a printing-ink emulsion and a dampening solution emulsion.

Fischer teaches a rotatable body having a circumferential surface for carrying a dampening-solution emulsion (water-ink emulsion See col. 3, lines 57 - 63).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Shiba et al. to have a rotatable body having the circumferential surface for carrying a dampening-solution as taught by Fischer et al. in order to provide an emulsion liquid in the printing application.

### ***Response to Arguments***

Applicant's arguments with respect to claims 17 - 22 have been considered but are moot in view of the new ground(s) of rejection.

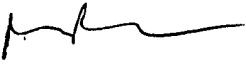
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marvin P. Crenshaw whose telephone number is (571) 272-2158. The examiner can normally be reached on Monday – Friday 6:45 – 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
MPC  
December 8, 2006

  
JUDY NGUYEN  
SUPERVISORY PATENT EXAMINER